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EXAMINER

QIN, YIXING

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,581

Applicant(s)

DABNEY ET AL.

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Arguments***

Applicant's arguments, filed 12/6/05, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. The Examiner has discussed with the Attorney the claims and has concluded that the specification does indeed indicate that a print driver UI can get number of copies information from a software application. As understood by the Examiner, the print driver UI would be an interface that would pop-up when an user selects, for example, a preferences or properties button on a print dialog box. The Examiner will point to additional information in the McComb reference.

The Examiner would also like to address the Shima reference briefly. The attorney has argued that the Shima reference (U.S. Patent No. 6,676,309) does not teach where control is transferred from an application to a print driver. However, as previously mentioned, Shima, teaches this idea in column 7, lines 7-12. Lines 9-12 especially discloses that this information that is received is used by the print driver to produce a control command, which would be used to control the printing process.

Please see the new rejection below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 1-3, 6-9, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McComb et al (*Using WordPerfect 6.1 for Windows*) in view of Shima (U.S. Patent No. 6,676,309).

1. Claim 1

- McComb discloses on page 301 and 302 that a user can access print preference through the edit menu in WordPerfect. One can see that by hitting, for example, an options button on page 290 of the McComb reference that one can access the additional print options. The number of copies is transferred from the print dialog to the print driver UI. Although the pages shown have copies set to 1, setting the number of copies to another number would also be reflected in the print preferences (i.e. the print driver UI).
- Similar options are also available on print dialog boxes of common programs like Word or Internet Explorer, where an user can choose print and then go to properties or preferences for a particular printer and select options related to the printer.
- McComb discloses on page 290 that there is a print quality box to be set for the copies. One would understand that changes here would be reflected in the print preferences box as well.
- McComb discloses a variety of features to the user as seen in the Fig. 8.7 on page 302.
- McComb discloses on page 302 that there are many choices such as the document settings or the size attribute ratio that can be offered to a user.
- McComb does not explicitly disclose that the control of printing is transferred from the application to the driver. The applicant's specification notes in Fig. 3 and on page 5, lines 3-5 that when the user clicks ok on a print dialog box, the control is transferred to the print driver from the application. The secondary reference, Shima, teaches this idea in column 7, lines 7-12.
- McComb does not explicitly disclose that the control of printing is transferred from the application to the driver. The applicant's specification notes in Fig. 3 and on page 5, lines 3-5 that when the user clicks ok on a print dialog box, the control is transferred to the print driver from the application. The secondary reference, Shima, teaches this idea in column 7, lines 7-12.
- Both references are in the art of printing through the use of a print dialog. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the control of the printing to be transferred to the print driver as mentioned in the Shima reference. The motivation would be to

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ensure proper printing as this is a necessary step in obtaining a printed document.

2. Claims 2 and 17

- McComb discloses on page 301 and 302 that a user can access print preference through the edit menu in WordPerfect. One can see that there is another box in there with arrows to reselect the number of copies.

3. Claims 3 and 18.

- From the last limitation of claim 1, one would understand that when a user clicks the OK button, the transfer of control occurs as is described in the Shima reference. One can select multiple copies in the number of copies box in the print dialog box on page 290 of McComb.

4. Claim 6

- One knows it is the user that selects the options that are offered by, for example, clicking a checkbox.

5. Claim 7

- One can see for example, in the McComb reference, that a setting such as print quality would be transferred to the print preferences box.

6. Claims 8 and 20

- Neither McComb nor Shima teach the displaying of a feature to explain the purpose and function of transferring control. However, the displaying of dialog/message boxes to help users or for explanation is well known (i.e. see Miller – U.S. Patent No. 5,442,687 and Palmer et al – U.S. Patent No. 5,825,355). One can see the help button on the interface on page 290 of McComb. One skilled in the art would also know that many programs include a help menu for the explanation of how to perform various tasks. The Examiner asserts that the displaying of an explanation of a task performed is an obvious engineering design choice (i.e. similar to if one wanted to have a message box popping up displaying what the number of copies box is for or what the print quality box is for in a print dialog).

7. Claim 9

- If the user has selected one copy in the number of copies box in the print drive UI, then this number would be updated in the software application UI as well.

8. Claim 16

- Please see claims 1 and 9 above.

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II. Claims 4, 5, 10-15, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McComb et al (*Using WordPerfect 6.1 for Windows*) in view of Shima (U.S. Patent No. 6,676,309) and further in view of Naik et al (U.S. Patent No. 5,579,446)

9. Claims 4 and 19

- McComb does disclose in the figure on page 302 (bottom) that there is a checkbox for reformatting the document to the currently selected printer on open. Neither McComb nor Shima explicitly teach that a user can select that there is a problem printing multiple copies.
- However, the tertiary reference, Naik, discloses in Figs. 4 and 5 and column 6, lines 48-60 that there is a print driver setup dialog 60' that shows options to change, for example, color options. Fig. 5 discloses further options for manual color and a pop-up message indicating to the user the merits of using either the automatic or manual printing.
- The Examiner does not that this is not explicitly disclosing a problem printing multiple copies, but the concept of enabling an user to select a box to be able to correct a possible problem (in Haik's case, manual adjustments could be made to correct a color problem – Haik notes in Fig. 5 item 80' that automatic button is for a recommended setting). This is similar to the Applicant's invention of the checkbox for problem printing multiple copies that enables a user to select a box to be able to see information on how to correct a problem. The Examiner believes that multiple copy printing is well-known enough that one of ordinary skill can apply this concept as mentioned in the McComb and Haik's references to multiple copy printing.
- Also, as noted before, proofing/test printing a document is understand to be a way to print one copy of a document, which effectively addresses the idea of having an user check a problem printing multiple copies box and having the number of copies set to one. (Note Gauronski – U.S. Patent No. 5,164,842, Fig. 11)
- All three references are in the art of printing through the use of a dialog. This will serve as the motivation for the combination of these references from hereon. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a dialog/or have boxes to enable a user to acknowledge that a problem occurred with printing multiple copies. The motivation would be to enable a user to know a problem that occurred during the printing process so that the user may find a way around it.

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10. Claim 5

- As seen in Fig. 5 of Haik, the message box that comes up tells the user that there is an automatic option for recommended settings, but manual settings are available, however, if the user wants manual control of the color settings. This indicates that there may be a problem with color settings (i.e. color correction is needed) in order for a document to print correctly. As mentioned above in claim 4, one can apply this concept to multiple copy printing as well.

11. Claim 10

- These limitations have been discussed in claims 1 and 4 above.

12. Claim 11

- Please see claim 6 above.

13. Claim 12

- Please see claim 7 above.

14. Claims 13 and 14

- None of the references disclose duplex or stapling options. However, the Examiner takes Official Notice that duplexing and stapling are very common printing options.

15. Claim 15

- Although not explicitly stated by the references, McComb's interface on page 290 has a help button. One of ordinary skill knows that this leads to a help menu in which an user can obtain information regarding how to perform various tasks. It would be an obvious design choice to simply pop up help boxes relating to performing a task when a user is choosing options for that task.

16. Claim 21

A print driver UI method for printing copies of a document, comprising:

- **receiving a number corresponding to a plural number of copies of the document to be printed from a software application;**
- Please see claim 1 above.
- **receiving at least one command relating to one of stapling or duplexing being performed on each of the plural number of copies to be printed;**
- Please see claims 13 and 14 above.
- **displaying a first feature to a user that informs the user that the software application may have a problem printing multiple copies and instructs the user on how to access the print driver UI;**
- Please see claims 5 and 15 above.

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- **offering the user an opportunity to reselect the number of copies to be printed;**
- Please see claims 2 above.
- **offering the user an opportunity to select there is a problem printing multiple copies**
- Please see claim 4 above.
- **transferring control of printing the copies from the software application to the print driver in response to a user selection.**
- Please see the last limitation of claim 1 above.
- **displaying a second feature to the user that explains the purpose and function of transferring control of printing the copies from the software application to the print driver; and**
- Please see claim 8 above.
- **reporting to the software application that one copy will be printed.**
- If one copy is selected in the number of copies box in page 302 of McComb, then one copy will be reported to the software application and one copy will be printed.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381.

The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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